REMARKS

Applicant acknowledges with appreciation the withdrawal of *Jacobson* as an anticipating reference.

Following a detailed review of the newly-cited art, Applicant submits that *Visser*[1] fails to disclose one or more limitations of claim 1.

VISSER

Visser discloses a system for reminding a person that a particular element fails to comply with a rule. As shown in FIG. 2A, *Visser*'s system determines when an element is out of compliance with a rule (step **152**). It then notifies a responsible party, whose job is presumably to correct the problem (step **154**). After the lapse of some time (step **156**), the system checks to see of the element is still out of compliance (steps **158**, **160**). If so, the *Visser* system reminds the responsible party that he has not yet corrected the problem (step **154**).

SECTION 103 REJECTION OF CLAIM 1

The Office rejects claim 1 as being rendered obvious by the combination of *Visser* and *Lineman*.[2]

Visser fails to teach "enterprise knowledge-base"

As best understood, the Office regards claim 1's limitation of "providing an enterprise knowledge-base containing information representative of enterprise elements" as being met by the element database **22b** in *Visser*'s FIG. 1a.

Applicant submits that one of ordinary skill in the art who has read the specification would not view element database **22b** as containing information representative of "enterprise elements" as that term is used in the specification.

One of ordinary skill in the art who was reading the *Visser* specification would have endeavored to ascertain what precisely *Visser* means by "element." In so doing, he would have

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[1] *Visser* et al., US 2003/0153991, filed 7/22/2002.
[2] *Lineman* et al., US 2003/0065942, filed 9/28/2001.

discovered that paragraph 3 of *Visser* describes an "element" as "tasks" or "pieces of equipment". Specifically, one of ordinary skill in the art would have learned that:

> "the entity is often charged with the duty to monitor data that is characteristic of a task or of a piece of equipment and further to assess whether the characteristic data of *such an element* is within acceptable parameters of one or more applicable rules"[3]

One of ordinary skill in the art would have also have appreciated *Visser's* distinction between an "entity" and an "element." Specifically, one of ordinary skill in the art would have read the following passage from *Visser*:

> A compliance management system aids an entity in managing aspects of its operations or business that are subject to criteria, rules or regulations, collectively referred to herein as rules. The rules may be varied and fluid. More particularly, an entity implementing such a system is directed to achieve compliance if at all possible. An entity can include an individual, a business or some form of organization. The present invention provides apparatus and methodology for monitoring these aspects and assisting the entity in ensuring continued compliance and compel correction should an element of their operation or business become out of compliance.[4]

From the foregoing paragraph, one of ordinary skill in the art would have understood that *Visser* chose the word "entity" to refer to the elements of an enterprise, and that the word "element" was intended to refer to something *other than* the elements of an enterprise.

To confirm his understanding of what *Visser* meant by "element," one of ordinary skill in the art would have searched *Visser's* specification for examples of "element." In doing so, one of ordinary skill in the art would have found four examples: a storage tank in a refinery,[5] a centrifuge in a laboratory,[6] reagent materials in a laboratory,[7] and student assignments, such as lab reports,[8] in a school setting. None of these examples would have given one of ordinary skill in the art that *Visser* contemplated "element" as including elements of an enterprise.

In an effort to confirm his understanding of exactly what sort of data is in the element database **22b** of FIG. 1a, one of ordinary skill in the art would have tried to understand precisely how data enters *Visser's* element database **22b**. In doing so, one of ordinary skill in the art would

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[3] *Visser*, paragraph 3.
[4] *Visser*, paragraph 34.
[5] *Visser*, paragraph 119.
[6] *Visser*, paragraph 124.
[7] *Visser*, paragraph 128.
[8] *Visser*, paragraph 132.

have discovered that the handheld device **35** shown in FIG. 1a is used to collect element data and to provide it to the element database **22b**.[9]

One of ordinary skill in the art who viewed Applicant's claim 1 would turn to Applicant's specification to understand what claim 1's term "enterprise knowledge-base" contains. According to the specification, an "enterprise knowledge-base includes "information descriptive of the enterprise whose regulatory compliance is sought." One of ordinary skill in the art would have understood that this was plainly inconsistent with the type of data stored in *Visser*'s element database **22b**.

Applicant recognizes that the word "element" is used in *Visser*. However, the patent examination process requires a search for the claimed invention, and not a search for words used to claim the invention. It would have been plain to one of ordinary skill in the art that *Visser* is concerned with compliance of hardware elements, such as storage tanks and centrifuges, or confirming completion of tasks, and not with "enterprise elements."

Visser fails to teach first and second sets of rule associations

Claim 1 requires defining separate and distinct sets of rule associations between subsets of applicable rules and subsets of elements. Specifically, claim 1 recites:

> defining a first set of rule associations between a first subset of the applicable rules and a first subset of the enterprise elements;

and

> defining a second set of rule associations between a second subset of the applicable rules and a second subset of the enterprise elements,

The Office has not indicated where precisely these two limitations are disclosed in *Visser*. Nor has Applicant been able to identify any plausible disclosure of these limitations.

Lineman fails to remedy the foregoing teachings of *Visser*. Accordingly, the combination of *Lineman* and *Visser* would still lack the foregoing claim limitations. Based on the foregoing,

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[9] *Visser*, paragraph 45.

Applicant submits that the section 103 rejection of claim 1 and progeny is improper and requests its reconsideration and withdrawal.

Motivation to combine references is flawed

The Office concedes that *Visser* alone fails to disclose claim 1's limitations of "assigning compliance scores" to both sets of rule associations. The Office however notes that *Lineman* teaches assigning scores to different computers, with each score indicating how well that computer complies with security procedures. *Lineman* also teaches displaying those compliance scores graphically.

The Office then proposes that one of ordinary skill in the art would have found it obvious to modify *Visser* to include some sort of compliance score assignment as disclosed by *Lineman*.

According to *KSR*,[10] the Office must provide "some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." As the required "articulated reasoning" the Office offers the following:

> "it would have been obvious to have modified the teachings of *Visser* to have specific numerical scores in order to facilitate the rule compliance management by individually analyzing individual element's actual compliance range to the organization's specific rules and regulation."

One of ordinary skill in the art would have understood from FIG. 2a of *Visser* that *Visser's* system was intended to notify a person if an element, such as a storage tank, was out of compliance. One of ordinary skill in the art would have seen no advantage to assigning some sort of compliance score to a storage tank and then displaying that compliance score to a compliance officer. In *Visser*, the decision as to whether the storage tank is out of compliance would already have been made in step **152**. One of ordinary skill in the art would have seen no purpose to assigning a compliance score to the storage tank and providing that score to whoever is supposed to fix the tank.

The proposed motivation to combine the references is therefore flawed. Accordingly, the section 103 rejection is improper and should be withdrawn.

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[10] *KSR Intern. Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1741 (2007).

Claims 9 and 17 include limitations similar to claim 1 and are patentable for at least the same reasons. The remaining claims are patentable for at least the same reasons as the claims from which they depend.

SUMMARY

Now pending in this application are claims 1-10, 13, 15-18, and 20-24, of which claims 1, 9, and 17 are independent. No additional fees are believed to be due in connection with the filing of this response. However, to the extent fees are due, of if a refund is forthcoming, please adjust our deposit account 06-1050, referencing attorney docket 16190-0002001.

Respectfully submitted,

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